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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,705	02/01/2006	Akira Ichikawa	Q92872	8042

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EXAMINER	
KIM, EUNHEE	

ART UNIT	PAPER NUMBER
2123	

MAIL DATE	DELIVERY MODE
12/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,705	ICHIKAWA ET AL.	
	Examiner	Art Unit	
	Eunhee Kim	2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 09/22/2008 has been received and considered. Claims 1-21are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Vinciarelli et al. (US Patent No. 6,847,853).

As per claim 1, 3, and 5, Vinciarelli et al. teaches an automated design system for performing automated design of a product (Fig. 5) comprising:

design rule storage means for storing a design rule (Fig 5, Col. 22 lines 35-46),

automated design means for performing automated design (Fig. 5, Col. 22 lines 15-17) using design requirement particulars with respect to a design of the product required by a customer or a designer (Col. 22 lines 15-17), designer discretion particulars by discretion of the designer with respect to the design of the product (Col. 21 lines 66-67, Col. 22 lines 30-40, Col. 26 lines 56-59), and the design rule necessary with respect to the design of the product (Fig 5, Col. 22 lines 35-46),

determination rule input means for inputting a determination rule including a rule, which is to be satisfied by design of the product in the case of manufacturing the product, and comprises at least one parameter which is in addition to the design requirement particulars, the

designer discretion particulars and the design rule (Fig. 5, Col. 27 lines 26-47, mechanical and thermal design/analysis),

determination rule storage means for storing the determination rule (Fig. 5, Col. 27 lines 26-47, Col. 29 lines 29-59, mechanical and thermal design/analysis),

design result determination means for determining whether a design result obtained by the automated design means satisfies the determination rule stored in the determination rule storage means (Col. 29 lines 49-52), and

determination result storage means for storing a determination result obtained by the design result determination means (Abstract, host computer).

As per claim 2, 4, and 6, Vinciarelli et al. teaches (Claim 4 and 6) reading out the determination result stored in the storing the determination result (Abstract) and

(Claim 2, 4, and 6) the design rule stored in the design rule storage means is updated by reflecting the determination result (Col. 27 lines 26-47).

As per claim 7, 8, and 9, Vinciarelli et al. teaches wherein the determination rule is based on at least one of technical condition or operational state and schedule rules of a producer, a factory, a line and equipment, component inventory cooperation rules, purchase component selection rules, environmental control-capable rules, and illegal export prevention rules (Col. 27 lines 26-47).

As per claim 10, 12, and 14, Vinciarelli et al. teaches wherein the at least one parameter is not addressed by the requirement particulars, the designer discretion particulars and the design rule (Col. 27 lines 26-47).

As per claim 11, 13, and 15, Vinciarelli et al. teaches wherein the requirement particulars, the designer discretion particulars and the design rule address a plurality of other parameters, each of which is not addressed by the at least one parameter of the determination rule (Col. 27 lines 26-47).

As per claim 16-18, Vinciarelli et al. teaches retrieval processing means for retrieving the determination results stored in the determination result storage means (Col. 32 lines 52-58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinciarelli et al. (US Patent No. 6,847,853), in view of Pet (US Pub No. 2005/0108172).

Vinciarelli et al. teaches most all of the instant invention as applied to claims 1-18 above.

However, Vinciarelli et al. fails to teach explicitly a patent infringement prevention rule.

Pet teaches a patent infringement prevention rule (Abstract).

Vinciarelli et al. and Pet are analogous art because they are both related to system for detecting infringement of an intellectual property.

Therefore, it would have been obvious to one of ordinary skill in the art of at the time the invention was made to have included the teaching of Pet, in the method of fabrication rules based automated design and manufacturing system of Vinciarelli et al. to promote various service, products, and process (Pet: [0008]).

Response to Arguments

4. Applicant's arguments filed 09/22/2008 have been fully considered but they are not persuasive.

Applicants have argued that:

> Further, even ignoring the fact that the rejections are improper, Applicant respectfully submits that the Vinciareili reference still fails to teach or suggest each and every limitation of the claims. In particular, Applicant respectfully submits that Vinciarelli fails to teach or suggest at least the following limitation of claim 1 :
>
> determination result storage means for storing a determination result obtained by the design result determination means .
>
> In the Office Action, the Examiner fails to cite any teaching or suggestion of Vinciarelli :for the above recited claim limitation. Further, Applicant's own review of the reference has failed to find any disclosure of Vinciarelli that could be said to teach or suggest this limitation of tile claim. Accordingly, Applicant respectfully submits that Vinciarelli failils to teach or suggest at least the above recited limitation of claim 1. Applicant further respectfully submits that claims 3 and 5 each recite similar limitations which Vinciarelli also fails to teach or suggest. As such, Applicant respectfully submits that Vinciarelli fails to teach or suggest each and every limitation of the claims.

Examiner disagrees and takes the position that Vinciareili teaches all the limitation cited above. Particular parts that teaches the limitation cited are directed. In particular a host computer is determination result storage means for storing the completed design (a determination result).

Regarding new claims, applicant's arguments have been considered and new ground of rejection was made, in view of Vinciarelli et al. and Pct.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eunhee Kim whose telephone number is 571-272-2164. The examiner can normally be reached on 8:30am-5:00pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached on 571-272-3753. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eunhee Kim/
Examiner, Art Unit 2123

/Paul L Rodriguez/
Supervisory Patent Examiner, Art Unit 2123